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EXAMINER
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* FERDINAND HENDRIKS, JOHN P. KARIDIS,  
GREGORY F. RUSSELL, ZON-YIN SHAE, and XIPING WANG

Appeal 2008-1648  
Application 10/081,941<sup>1</sup>  
Technology Center 2400

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Decided: October 29, 2008

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Before JEAN R. HOMERE, ST. JOHN COURTENAY III, and THU A.  
DANG, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 55. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

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<sup>1</sup> Filed on February 22, 2002. The real party in interest is International Business Machines Corp.

*The Invention*

Appellants invented a method and apparatus for annotating instant text messages in a real-time messaging system. (Spec. 1.) As depicted in Figures 2 and 3, upon joining an ongoing instant messaging (IM) session, a user may contribute to the session by directly inputting handwritten stroke information objects in the current chat record of the IM session. (Spec. 7-8.) The user's addition of handwritten characters to the IM session thus annotates the chat record, which is shared with other IM users. (*Id.*)

Independent claim 1 further illustrates the invention. It reads as follows:

1. A method for annotating instant text messages in an instant messaging system for communication within an interconnected network of computers comprising:

establishing by at least some of the network of computers a connection to said instant messaging system;

providing to a plurality of users by said instant messaging system a graphical user interface comprising a recording field;

displaying in said recording field for viewing by said users a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session;

directly inputting handwritten stroke information message objects anywhere within said recording field to thereby annotate said one or more instant text messages in said chat record; distributing by said instant messaging system said annotated one or more instant text messages for viewing by said plurality of users in said recording field,

*Prior Art Relied Upon*

The Examiner relies on the following prior art as evidence of unpatentability:

Sun	US 2002/0143994 A1	Oct. 3, 2002 (filed Mar. 30, 2001)
Shiigi	US 6,564,249 B2	May 13, 2003 (filed Oct. 15, 2001)
Lloyd	US 6,779,178 B1	Aug. 17, 2004 (filed Sep. 16, 1999)

*Rejections on Appeal*

The Examiner rejects the claims on appeal as follows:

A. Claims 1 through 13, 18 through 30, 35 through 47, and 52 through 55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Shiigi and Sun.

B. Claims 14 through 17, 31 through 34, and 48 through 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Shiigi, Sun, and Lloyd.

*Appellants' Contentions*

Appellants argue that Shiigi and Sun are not properly combined to teach directly inputting handwritten stroke information message objects anywhere within the recorded field of a graphical user interface to thereby annotate an IM chat record. (App. Br. 14-16, Reply Br. 4-5.) Particularly, Appellants argue that Shiigi is limited to an email system that handles

handwritten or hand drawn messages, and that Sun is limited to using ink data in an IM system. (*Id.*) However, Appellants argue that the cited combination lacks the claimed recording field for inputting ink data to annotate an IM chat record. (*Id.*) Further, Appellants argue that there is insufficient rationale for combining the cited references as suggested by the Examiner. (*Id.*) Additionally, Appellants argue that Shiigi teaches away from the claimed invention since it discourages the use of text messages. (*Id.* 15.)

*Examiner's Response*

In response, the Examiner finds that Shiigi teaches an input area for allowing a user to input handwritten messages that are electronically mailed to other users. (Ans. 9.) Further, the Examiner finds that Sun complements Shiigi by teaching a system that allows users input handwritten characters in an IM chat session to thereby share the handwritten characters with other participants of the IM session. (Ans. 9-11.) Therefore, the Examiner concludes that the combination of Shiigi and Sun renders claim 1 unpatentable. (*Id.*)

II. ISSUE

Thus, the pivotal issue before us is whether one of ordinary skill would have found sufficient rationale to combine Shiigi and Sun's teachings to yield a recording field for inputting therein handwritten stroke

information message objects to thereby annotate an IM chat record, as recited in independent claim 1. We answer this inquiry in the affirmative.

### III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

#### *Shiigi*

1. Shiigi discloses a method and system for allowing a user to electronically mail handwritten or hand drawn messages to other users. Particularly, Shiigi discloses a graphical data capture in a computer client for allowing the user to handwrite or hand draw messages to be sent to desired recipients via e-mail. (Col. 4, ll. 20-25, ll. 44-49.)

#### *Sun*

2. Sun discloses a method and system wherein a participant in an existing IM chat session can input handwritten and hand drawn messages in an electronic tablet in a client computer for sharing the input information with other participants in the IM session. (P. 3, para. [0026]-[0027].)

### IV. PRINCIPLES OF LAW

#### Obviousness

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86

(Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

*KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) wherein evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739-40 (2007)). “One of the ways in which a patent's subject matter can be proved obvious is

by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.” *KSR*, 127 S. Ct. at 1742.

The reasoning given as support for the conclusion of obviousness can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art. *KSR*, 127 S. Ct. at 1740-41. *See also Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006).

## V. ANALYSIS

As detailed in the Findings of Facts session, Shiigi teaches a system for allowing a user to input handwritten or hand drawn characters in a graphical data capture to thereby email the handwritten data to other e-mail clients. (FF. 1.) Further, Sun teaches a system that complements Shiigi’s teachings by allowing a user to input handwritten or hand drawn characters in an existing IM chat session to thereby share the input handwritten characters with other participants of the session. (FF. 2.) One of ordinary skilled in the art would readily recognize that there has to be a chat record in an ongoing chat session. Therefore, by allowing a user to add hand drawn characters in the communication to be shared with other chat participants, Sun teaches annotating the chat record by adding handwritten characters therein. The ordinarily skilled artisan would have thus recognized that



Shiigi and Sun disclose prior art elements that perform their ordinary functions to predictably result in a system that allows an IM participant to input in a graphical data capture handwritten characters to be shared with other IM participants thereby annotating the chat record of an existing chat session. We therefore agree with the Examiner that the combination of Shiigi and Sun is proper. For these same reasons, we find Appellants' argument that Shiigi teaches away from the invention to be unpersuasive.

It follows that Appellants have not shown that the Examiner erred in concluding that the combination of Shiigi and Sun renders independent claim 1 unpatentable.

Regarding claims 2 through 55, Appellants essentially restate the same arguments offered for claim 1 above (App. Br. 13-18). Therefore, we select independent claim 1 as being representative of the cited claims. Consequently, claims 2 through 55 fall together with representative claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

## VI. CONCLUSIONS OF LAW

Appellants have not shown that the Examiner erred in concluding that the combination of Shiigi and Sun renders claims 1 through 13, 18 through 30, 35 through 47, and 52 through 55 unpatentable under 35 U.S.C. § 103 (a). Similarly, Appellants have not shown that the Examiner erred in concluding that the combination of Shiigi, Sun, and Lloyd renders claims 14

Appeal 2008-1648  
Application 10/081,941

through 17, 31 through 34, and 48 through 51 unpatentable under 35 U.S.C.  
§ 103(a)

#### VII. DECISION

We affirm the Examiner's decision rejecting claims 1 through 55 as being unpatentable under 35 U.S.C. § 103(a) .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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